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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 08/425,766 | 04/19/1995 | RALPH F. GREENE | 017220.0115 | 1902 |

7590

01/14/2005

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EXAMINER

NORMAN, MARC E

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3744

DATE MAILED: 01/14/2005

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GROUP 3700

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 08/425,766
Filing Date: April 19, 1995
Appellant(s): GREENE ET AL.

1 September 2004
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to the Remand to the Examiner from the Board of Patent Appeals and Interferences dated 31 July 2003 and further related to appellant's brief filed 7 September 1999.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is deficient because it does not include language relating to the liquid filter element for capturing particulate matter in exhaust gasses, which is the focal point of the "recapture" debate. Appellant's reissue application attempts to broaden the claim language by withdrawing the liquid filter element from independent claims 1 and 15. Such withdrawal, examiner contends, violates the equitable Recapture Doctrine in the manner set forth in the original Examiner's Answer and further in the supplemental Grounds of Rejection, below.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-20 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-20 are rejected under the equitable Recapture Doctrine as set forth in MPEP 1412.02. This rejection is fully set forth in the original Examiner's Answer mailed on 21 December 1999. That rejection is hereby carried forward and maintained in view of the discussion that follows under Response to Argument.

(11) *Response to Argument*

The case was remanded by the Board of Patent Appeals and Interferences on 31 July 2003. In the Remand, the Examiner was requested to determine whether the rejection under 35 U.S.C. § 251 remains appropriate in view of *Ex parte Eggert*, (67 USPQ2D 1716, Appeal No. 2001-0790 (Bd. Pat. App. & Inter. May 29, 2003)).

In *Ex parte Eggert*, the Board of Patent Appeals and Interferences rendered a decision stating that a reissue claim that broadens a limitation relied upon to overcome a rejection would avoid the recapture rule since the relied-upon limitation is still present in the claim, albeit in a broadened form.

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The Examiner submits that the decision regarding *Ex parte Eggert* is not directly relevant to the present case. The only rejection in the present reissue application is based on recapture of subject matter surrendered by arguments made during prosecution of the original application. The surrendered subject matter which the reissue application seeks to recapture is identified as the broadened claim subject matter resulting from the deletion of the original patent "liquid filter" claim limitations.

Prosecution of the original patent occurred in application No. 07/643,419 and in continuing application No. 07/804,474, which matured into the original patent. In applicants' August 19, 1991, paper No. 5 reply to the examiner's 1st Office action in application No. 07/643,419, applicants made the arguments which surrendered the subject matter now sought to be recaptured in the present reissue application. The arguments in paper No. 5 distinguished applicants' invention over the prior art by referring to features not present in the applied art. The following are statements made in paper No. 5 relating to those features:

1. "...an important aspect of this invention is the reversed order of conventional systems employing dual incinerators" (page 2, 3rd paragraph).
2. "...Hadley also fails to teach or mention a liquid filter arrangement as described and claimed by Applicants" (page 3, 1st full paragraph).
3. "...the cooling tower of Kent is entirely different and serves a completely separate purpose from the 'liquid filter' of Claims 1-14..." (page 4, 2nd paragraph)

The arguments in paper No. 5 relating to these 3 statements were immediately followed by the following assertion "Applicants have shown that each of the references relied on omit critical features of Applicants' invention." (Emphasis added.) The 3 statements relate to two

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features of applicants' invention. Statement 1 relates to the first and second combustion chambers of the claimed invention. Statements 2 and 3 relate to the "liquid filter" limitations in original patent claims 1 and 15 which were deleted in the present reissue application. Therefore, the "liquid filter" limitation must be one of the "critical features" asserted by applicants as having been shown to be lacking in the prior art.

On page 4 of their September 7, 1999 Appeal Brief, applicants argued that "recited combustion chambers and the order of their operation were *the* important aspects of the invention..." and "[T]he mere fact that Appellants also pointed out that the prior art failed to teach or suggest the recited filter element... does not in any way amount to an admission that the recited filter element was *necessary* to overcome the prior art." Notwithstanding applicants' arguments that the "liquid filter" limitation was not necessary to overcome the prior art, applicants' characterization of the "liquid filter" limitation as one of the two "critical features" resulted in a surrender of a claim omitting the liquid filter limitation.

In the present instance, in order to overcome the prior art rejection, the applicants specifically relied in their argument on the criticality of the "liquid filter" element for *all* of the claims that were allowed in the patent. The applicant voluntarily and deliberately chose not to prosecute variations of the original claims which omitted the "liquid filter" element. At the present, on reissue, applicant is not permitted to completely delete this element by way of the reissue claims. See *Hester Industries, Inc. v. Stein, Inc.* 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998) for the principle that limitations relied upon to define patentability, although they were not added via amendment in the original application, will establish a surrender of claim subject matter. When the surrender is made by way of argument alone, "we simply analyze the

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asserted reissue claims to determine if they were obtained in a manner contrary to the arguments on which the surrender is based.” Id at 1649. The present reissue claims entirely omit a feature clearly asserted by applicants to be “critical” in defining over the art, and the reissue claims have not been narrowed in any respect.

Accordingly, the facts of the recapture rejection are not analogous to the facts in *Ex Parte Eggert*, (67 USPQ2D 1716, Appeal No. 2001-0790 (Bd. Pat. App. & Inter. May 29, 2003)). In *Eggert*, the critical limitation was broadened rather than omitted.


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

MN

January 6, 2005

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